

REMARKS

This paper is filed in response to the Office action mailed on October 18, 2006. In that Office action, claims 10-11 and 19-22 are withdrawn as being directed to a nonelected invention; claims 1-9 and 12-18 stand rejected; and claims 15-18 are objected to but indicated as being allowable. In view of the amendments and remarks submitted herewith, reconsideration and allowance of all pending claims are respectfully requested.

Claim 5 stands rejected under 35 U.S.C. 112, first paragraph, as failing to satisfy the enablement requirement. More specifically, the Office asserts that the specification is inadequate to teach a person skilled in the art (1) why pre-cured dental composite attached to the middle portion of the matrix band would be "beneficial" or (2) the amount of the dental composite that needs to be applied to the band

Applicant respectfully traverses this rejection. Under MPEP § 2164.01,

"[the] standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In *re Wands*, 858."

According to the specification, the pre-cured dental composite material attached to the middle of the matrix band obtains or restores the contact area between the two teeth and becomes a part of the filling (page 7, line 26-28). The relative amounts of the pre-cured composite material is shown at 14 in Figures 1A, 3, and 4. A complete description of this claim element can also be found at page 3, lines 18-27.

Applicant respectfully submits that the benefit of the pre-cured dental composite material attached to the middle of the matrix band and the relative amount of the composite material on the band would be readily appreciated by those skilled in the art upon review of the aforementioned figures and description. In contrast to the assertion by the Office, the specification clearly teaches the benefit of claim 5 and the figures teach the relative amount of composite needed to one skilled in the art.

Accordingly, this rejection is improper and should be withdrawn, as claim 5 is clearly enabled by Figures 1A, 3 and 4, as well as page 3, lines 18-27 and page 7, lines 26-28.

Claims 2 and 3 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Office takes issue with the recitation in claim 1 that the legs are *connected* to the proximal ends of the arms, while claim 2 recites that the legs are *extensions* of the saddle; and claim 3 recites that the legs are *extensions* of the proximal ends of the arms. Applicant has amended claim 1 to recite that the proximal ends of the arms are each *coupled* to the straddle and a downwardly extending leg. As now claimed, the legs can be extensions of the straddle and coupled to the proximal ends of the arms as specified in claim 2 or the legs can be extensions of the arms and coupled to the straddle as specified in amended claim 3. Applicant respectfully submits that claims 2 and 3 merely provide for the possibility that the legs can be fabricated from the piece of material used to fabricate the straddle (claim 2) or the arms (claim 3). Thus, the relationship between the legs and the straddle or arms needs no further definition. Claims 2 and 3 are definite and this rejection should be withdrawn.

Turning to the prior art rejections, claim 1-4, 7-9, and 12-14 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 4,718,852 ("Galler"). The Office appears to rely upon Figures 11 and 16 of Galler in making this rejection. The Office asserts that "Galler discloses a device for retaining a filling material during repair of a cavity, the device comprising a straddle (45) extending transversely between two parallel arms (40 and 41), and each arm being connected at a proximal end to the straddle and a distal end to a wedge (43 and 44)". The Office further asserts that there is "a leg (51 and 58) attached to each of the arms for receiving the loop end (50a and 50c) of a matrix band (50), . . . [which] is positioned so that it extends from one leg to the other along the arms and around the wedges (Fig. 16)".

In response, applicant has amended claim 1 to specify that the matrix band extends from one of the downwardly extending legs, below one of the arms, around the wedges, below the other arm and to the other downwardly extending leg. In contrast to the legs of amended claim 1, the matrix strip (50) of Galler is positioned

above both of the arms (40, 41) (see Galler at Figures 11-12, 14, 16, and 17), and therefore is not responsive to the matrix band recited in claim 1.

Further, because Galler's legs (51, 58) either extend downward from the end loop (50c) of the Galler matrix band (50) and not the Galler arms or straddle (40, 41, 45), or extend upward and not downward from the Galler arm (40), Galler's legs (51, 58) are not responsive to the downwardly extending legs of amended claim 1. Moreover, neither of Galler's legs (51, 58) is or could be coupled to the Galler straddle (45) in contrast to the recitation of claim 1.

Thus, the obviousness rejection fails to meet the standards of MPEP §2142 which requires:

"[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." Emphasis ours; citing, *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); see also MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

As Galler fails to teach or suggest a band extending below the arms of the device and legs for holding the band that extend downwardly from the arms and straddle, the obviousness rejection fails to establish a *prima facie* case of obviousness and must be withdrawn.

The Office asserts that it would have been obvious to one of ordinary skill in the art to modify the legs of Galler by rearranging them to the proximal ends of the arms (40, 41) or extending them from the straddle (45). Applicant respectfully disagrees with this assertion. In order to modify the Galler device to include each and every element of the amended claim 1, one of ordinary skill in the art would need to rearrange a plurality of key structural elements such as: (a) relocating the leg (58) from the matrix band (50) to the arm (41), (b) inverting both of the legs (51, 58) to

extend downward from the arms or straddle, and (c) rearranging both of the legs (51, 58) to be coupled to both the straddle (45) and the arms (40, 41). These changes would require a redesign of the straddle (45) and arms (40, 41). This proposed reengineering would significantly change the structure and configuration of the Galler device and one skilled in the art would not be motivated to do so without using the present application as a template. See MPEP § 2142, 2143.

In summary, Applicant respectfully submits that there is no suggestion or motivation to modify Galler reference as proposed in the Office Action; there is no reasonable expectation of success in carrying out such a modification; and Galler clearly does not teach suggest all the limitations, i.e. downwardly extending legs, matrix band below arms, etc.. As a result, a *prima facie* case of obviousness has not been established and this rejection should be withdrawn.

Claim 6 is rejected under 35 U.S.C. 103(a) as being obvious over Galler, and further in view of U.S. Patent No. 6,325,625 (hereinafter "Meyer"). As discussed above, Galler does not render the amended claim 1 obvious. It follows that the combination of Galler and Meyer would not teach and suggest all the limitations specified in claim 6. Therefore, applicant respectfully submits that this rejection should be withdrawn.

In the Office action, claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As the amended claim 1 is now in an allowable state, applicant respectfully submits that this objection should be withdrawn.

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In light of all the foregoing, applicant respectfully submits that each of the currently pending claims, i.e. claims 1-9 and 12-18, and 23 are in a condition for allowance and respectfully solicit an action indicating same. If a telephone call would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,

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